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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

HOEY, ALISSA L

ART UNIT	PAPER NUMBER
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3765

DATE MAILED: 10/03/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/910,641

Applicant(s)

HOLDEN, PERRIANN M.

Examiner

Alissa L. Hoey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 August 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-10,12-32 and 34-46 is/are pending in the application.
- 4a) Of the above claim(s) 2-4,7-9,12-20,34,42,43,45 and 46 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,10,21-32,35-41 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. The indicated allowability of claims 4,5,9 and 10 in paper No. 11, mailed October 29, 2002, is withdrawn in view of the rejections set forth below.
2. Amendment D, paper No. 14, filed February 7, 2003 and Amendment E, paper No. 18, filed August 18, 200 have been entered for purposes of this Office Action.

Election/Restrictions

3. This application contains claims directed to the following patentably distinct species of the claimed invention: a trimable foot pad and a preformed protector coupled to a pad.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

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Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Jerry Potts on 09/23/03 a provisional election was made with traverse to prosecute the invention of the trimable pad, claims 1, 5, 10, 21-32, 35-41 and 44. Affirmation of this election must be made by applicant in replying to this Office action. Claims 2-4, 6-9, 11-20, 33, 34, 42 and 43 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 5 and 10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 5 defines the invention as presently claimed as a kit having " a decoration to be applied to said bottom surface." As best

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understood, this required part of the kit sets forth a separate part of a decoration, which is to be applied to the bottom surface, when worn of the protective pad. The specification as originally filed provides a pad that is trimable and has a bottom surface layer that is decorated with a design. (See page 4, lines 4-8). There is no disclosure presented in the originally filed application to offer support for the claims as presently filed. Claim 10 requires that the method as presently claimed provide "decoration selected from at least one of the groups comprising color, pattern, graphic design, text, advertising, relief design and texture" in addition to a trimable pad with adhesive with a pealable film. The specification requires that the decoration be applied to the bottom surface of the pad. As presently claimed it could be applied to the adhesive, the second surface or the pealable film. Additionally claim 10 suggests, as best understood, that the pad is not only attached to a body part but to either a number of particular materials (claim 10). There is no disclosure presented in the originally filed application to offer support for the claims as presently filed.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 10 fails to correspond in scope with that which applicant regards as the invention can be found in Paper No. 7 filed May 20, 2002. In that paper, applicant has stated that the pad is decorated and applied directly to the wearers body (see page5 through page 7 of Applicant's arguments), and this statement indicates that the invention is different

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from what is defined in the claim(s) because the present invention alludes to the pad having a decorated side, an adhesive side and where the adhesive side has a removable cover which can be applied to the user's body or to a separate pre-formed cupped pad or material selected from a particular group as recited in claim 10.

9. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is questioned if the claim is an incompletely written method claim failing to suggest that the material of the protective pad be found in the particular material or shape or that the pad be attachable not only to the wearer's body, but to the particular material or shape.

Claim Objections

10. Claim 26 is objected to because of the following informalities: it seems claim 26 is not fully finished, since it ends in "a layer of acrylate adhesive on one of its."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 21-24, 29, 30, 31 and 32 are rejected under 35 U.S.C. 102(b) as being anticipated by Yonkers (US 3,985,383).

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Yonkers provides a flexible pad having an upper surface and a lower surface with a non-slip texture (figure 4, identifiers 18: column 2, lines 15-23). The pad being flexible to conform to a contoured surface area of a body part (figure 1, identifiers 10 and 11: column 2, lines 3-14). The pad having its entire upper surface coated with an adhesive material for removably securing the pad to the body part to facilitate decorating (figure 4, identifier 16: column 2, lines 66-68 through column 3, lines 1-13). The decorative indicia is chosen from colors and shapes (figure 6, identifiers 22, 24, 26 and 28: column 4, lines 10-19). The pad having its lower surface provided with indicia to decorate the contoured surface area (column 4, lines 10-19). A peelable material covering the adhesive to protect the adhesive material until ready for use (figure 5, identifier 20: column 4, lines 3-9). The non skid pad has sufficient thickness to protect the contoured area of a user selected body part from abrasion when brought into engaging contact with a ground surface (column 3, lines 14-29). The flexible pad conforms to the user's fingers and is made out of foam and sponge rubber (column 3, lines 14-50). The non-skid pad of Yonkers is capable of being trimmed and disposed of after use. Additionally, it is inherent that the adhesive of Yonkers is non-skin irritating (column 1, lines 66-68 through column 2, lines 1-2). Further, Yonkers teaches the method of providing a decorative pad with a non-slip texture to the finger of a user (column 1, lines 66-68 through column 2, lines 1-2).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers in view of Gamble et al (US 6,440,526).

Yonkers provides a non-slip decorative pad as described above in claims 23 and 24. However, Yonkers fails to teach the pad made out of ethylene vinyl acetate having a thickness of one sixteenth of an inch. Gamble et al. provides a non-slip pad with adhesive made out of ethylene vinyl acetate (column 4, lines 14-34).

With respect to the limitation that the pad has a thickness of one sixteenth of an inch. The specification contains no disclosure of either the critical nature of the claimed dimension or any unexpected results arising therefrom, and that as such the thickness of the pad being one sixteenth of an inch is arbitrary and therefore obvious. Such unsupported dimensions cannot be a basis for patentability, since where patentability is said to be based upon a particular dimension or another variable in the claim, the applicant must show that the pad being one sixteenth of an inch is critical. In re Woodruff, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal dimension for a particular application.

It would have been obvious to have provided the pad of Yonkers with the ethylene vinyl acetate material of Gamble et al., since the pad of Yonkers made out of ethylene vinyl acetate material would provide a pad that efficiently absorbs shock and who's surface can be easily modified as desired and embossed.

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15. Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers in view of Muchin (US 5,718,224).

Yonkers provides a non slip pad as described above in claims 23 and 24. However, Yonkers fails to teach the adhesive material being acrylate polyurethane tape having a thickness of 1.2 millimeters. Muchin provides a pad having an adhesive material made out of acrylate polyurethane tape (column 3, lines 35-40).

With respect to the limitation that the pad has a thickness of 1.2 millimeters. The specification contains no disclosure of either the critical nature of the claimed dimension or any unexpected results arising therefrom, and that as such the thickness of the pad being 1.2 millimeters is arbitrary and therefore obvious. Such unsupported dimensions cannot be a basis for patentability, since where patentability is said to be based upon a particular dimension or another variable in the claim, the applicant must show that the pad being 1.2 millimeters is critical. *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d 1934 (Fed. Cir. 1990). One having ordinary skill in the art would be able to determine through routine experimentation the ideal dimension for a particular application.

It would have been obvious to have provided the pad of Yonkers with the acrylate polyurethane tape of Muchin, since the pad of Yonkers having it's adhesive made out of acrylate polyurethane tape material would provide a pad that has adhesive material that is reusable and has a elastic properties to conform to the user's skin surface better and is more comfortable to the user.

16. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers in view of Lee (US 6,613,382).

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Yonkers provides a non slip pad as described above in claim 23. However, Yonkers fails to teach the decorative indicia being screen printed on the non slip pad. Lee provides a vinyl sheet having a printed surface and an adhesive surface, the printed surface is applied to the sheet by screen printing (column 3, lines 39-48).

It would have been obvious to have provided the non slip pad of Yonkers with the screen printed decorative indicia of Lee, since screen printing a decoration, color or design on a non slip surface is a way to provide decorative means to a adhesive article for aesthetic purposes.

17. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yonkers and Gamble et al. in view of Lee.

Yonkers and Gamble et al. provide a non slip pad as described above in claim 25. However, Yonkers and Gamble et al. fail to teach the pad of ethylene vinyl acetate being provide with screen printing. Lee provides a vinyl sheet having a printed surface and an adhesive surface, the printed surface is applied to the sheet by screen printing (column 3, lines 39-48).

It would have been obvious to have provided the non slip pad of Yonkers and Gamble et al. with the screen printed decorative indicia of Lee, since screen printing a decoration, color or design on a non slip surface is a way to provide decorative means to pad of ethylene vinyl acetate for aesthetic purposes.

Response to Arguments

18. Applicant's arguments with respect to claims 1-5, 7-10, 12-32 and 34-46 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rightmire, Stewart, Scholl, Scott, Loebeck, Spence, Jacob, Heinecke et al., Carver, Powell, Porcelli, Levy, Gochanour, Kypreos, Kluesner, Apple, Young, Ohira et al., O'Donnell et al., Cline et al., Cao, Lorkovic, Bonacci, Sullivan, Cavanagh et al. are cited to show closely related articles.

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alissa L. Hoey whose telephone number is (703) 308-6094. The examiner can normally be reached on M-F (8:00-5:30) Second Friday Off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on (703) 305-1025. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

alh


JOHN J. CALVERT
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